REMARKS

B. 35 U.S.C. § 112, first paragraph

The examiner has rejected claims 5, 6, 11, and 12 under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. Applicant traverses this ground of claim rejection for the reasons stated below.

The examiner has stated that the limitation "in its [un]compressed state" in claims 5 and 6 is an addition of new matter. The examiner has pointed to the specification on page 4, lines 18-24, and specifically lines 22-24, that state, "the thickness of cold weather insulation layer 20 may, for example, vary between .75 and 1.00 inches. It will be appreciated that the uncompressed cold insulating layer 20 provides superior cold weather insulation than does the compressed cold weather layer 4 of the prior art boot." The examiner has noted that this passage does not designate whether the thickness of the insulation layer is measured in its compressed or uncompressed state. The examiner therefore has concluded that the assumption of the uncompressed state lacks support.

Applicant respectfully disagrees. The specification makes clear that the invention is an improvement of prior art boots in which a layer of cold insulating material overlying the toe box was compressed by the leather outer layer, causing a reduction in the volume of thermal insulating dead air present in the cold insulating layer. [Specification, p. 1, lines 14-21.] The original (uncompressed) thickness of the cold insulating layer of these prior art boots was said to vary between approximately .315 and .54 inches, with the thickness after compression varying between approximately .119 and .276 inches. [*Id.*, p. 2, lines 6-10.] Compressed and uncompressed thickness ranges are provided for the cold insulating material of the prior art boot

because at different stages during fabrication the cold insulating material exists in both uncompressed and compressed states.

The cold insulating material of the present invention exists only in an uncompressed state. The cold insulating material is adhesively secured to the underside of the toe box. [*Id.*, p. 3, lines 12-13.] Because this material "is within toe box 18, it [is] not compressed by the stretching of the leather over the toe area as was the cold insulating layer 4 in the prior art boot." [*Id.*, lines 18-20.]

The oversized toe box is said to have a height that varies between 1.9 and 2.5 inches compared to a maximum height of 1.5 inches in the prior art boot. [*Id.*, p. 3, lines 9-11; p. 2, lines 15-16.] The increase in toe box height is consistent with the inclusion within the oversized toe box of cold insulating material having a thickness between .75 and 1.00 inches. [*Id.*, p. 4, line 23.] The toe box could be made considerably smaller, with resulting material cost savings, if the cold insulating layer in the finished boot was compressed.

Nothing in the specification suggests that cold insulating material 20 is compressed and no structure is present to cause any compression. The cold insulating material is not compressed by the leather outer layer because it is located within the oversized toe box. Nor is this material compressed by the action of the wearer's foot because the substantially larger interior of the oversized toe box 18 provides room for both cold insulating layer 20 and the wearer's toes. [*Id.*, lines 14-16.]

While the passage in the specification indicating the thickness of the cold insulating material does not expressly state that the material is present in its uncompressed state, the two preceding sentences and the following sentence all refer the material in its uncompressed state.

[*Id.*, p. 4, lines 18-19 ("cold . . . insulating layer . . . is not compressed"); lines 21-22 ("the consequent ability of cold . . . insulating layer 20 to retain heat is not reduced"); line 24 et seq. ("uncompressed cold insulating layer 20 provides superior cold weather insulation").] There can be no doubt that the indicated thickness measurement refers to the thickness of the material in its uncompressed state. No thickness measurements are provided for the material in its compressed state because the material is not compressed.

Based on the foregoing, applicant submits that the limitation "in its [un]compressed state" is not new matter and that the rejection of claims 5 and 6 under 35 U.S.C. § 112, first paragraph, therefore is improper. Accordingly, applicant requests that this ground for claim rejection be withdrawn.

The examiner also has stated that the limitation in claim 11 of "a thinner layer of cold insulating material extending below the second side of the lining" has no support in the specification. Applicant respectfully disagrees.

Fig. 3 shows quilted layer 10 extending below vamp lining 17. The specification describes the cold insulating properties of quilted layer 10. [*Id.*, p. 4, lines 1-3.] The thickness of quilted layer 10 is said to be about .24 inches compared to the .75 to 1.00 thickness of cold insulating layer 20. [*Id.*, lines 1 and 23.]

Applicant submits that the limitation "a thinner layer of cold insulating material extending below the second side of the lining" is not new matter and that the rejection of claim 11 under 35 U.S.C. § 112, first paragraph, therefore is improper. Accordingly, applicant requests that this ground for claim rejection be withdrawn.

The examiner also has stated that the limitation in claim 12 of a water-impermeable layer has no support in the specification. Applicant respectfully disagrees.

Waterproof bootie 8 may be adhesively secured to the underside of vamp lining 17. [*Id.*, p. 5, lines 5-6; see also Fig. 3.] The specification described the water-impermeable properties of the bootie 8. [*Id.*, p. 3, lines 17-18.]

Applicant submits that the limitation of a water-impermeable layer is not new matter and that the rejection of claim 12 under 35 U.S.C. § 112, first paragraph, therefore is improper. Accordingly, applicant requests that this ground for claim rejection be withdrawn.

B. 35 U.S.C. § 103(a)

The examiner has rejected claim 5, 6, and 10 under 35 U.S.C. § 103(a) as being unpatetentable over international reference WO 92/14372 ("WO '372") in view of U.S. Patent No. 3,805,419 to White ("White"). The examiner also has rejected claims 8 and 9 under U.S.C. § 103(a) as being unpatentable over White or U.S. Patent No. 4,102,062 to Adams ("Adams") in view of the references as applied to claim 10. The examiner also has rejected claims 8-9, 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable in view of various combinations of references including those applied to claim 10.

The examiner contends that WO '372 discloses all of the limitations of the claimed invention except for the insulating material being located but not compressed between the toe box and the lining. The examiner contends that White teaches an insulating layer 5 for a toe protected boot located, uncompressed, between the toe box 1 and a lining 6. The examiner has argued that it would have been obvious to one of ordinary skill in the art at the time the invention

was made to place an insulating layer between the toe box and the liner of WO '372 as taught by White to insulate the boot.

WO '372 discloses a boot having an removable protective insert. The insert includes a fabric backed foam layer 43 and, in some embodiments, a toe cap 27. Comparison of Fig. 3 (no toe cap) with Figs. 2 and 4 (with toe caps) shows that a layer of foam having an uniform thickness is provided over an area corresponding to the top of a user's forefoot with this layer being compressed to a smaller thickness in the regions where the toe cap is present.

White discloses an article of safety footwear with a cushioning layer 5 extending below toe cap 6. White teaches that a foam layer on the underside of the toe cap aids in the manufacture of a separate toe cap assembly that can be inserted into an essentially finished article of footwear as cushioning the inside of the toe cap. [White, col. 5, lines 14-17 and 52-57.]

Applicant respectfully submits that the combination of WO '372 and White is improper. No motivation has been shown for combining the uncompressed foam layer of White, which is provided to achieve manufacturability of a separate toe cap assembly with a toe cap integrally anchored within the molded plastic of the removable shoe insert of WO '372. Absent such a showing, applicant respectfully requests that the claim rejections based on this combination be withdrawn.

Even if the combination of WO '372 and White were proper, applicant respectfully submits that claim 10 presented herein is patentable over these references. Nothing in WO '372 teaches or suggests that the foam layer provides any cold insulating function. The foam layer of WO '372 is said to provide only a cushioning function. In addition, the compression of the foam under the toe caps of WO '372 suggests that the cold insulating properties of the boot are not of

interest. Nor does anything in White teach or suggest a foam layer having a cold insulating function. The foam layer of White provides cushioning and aids in the manufacturing of the toe cap assembly.

Applicant also finds nothing in either WO '372 or White that teaches or suggests an oversized toe box, *i.e.*, a toe box sized to enclose a sufficient quantity of insulating material to provide enhanced thermal protection of a user's foot without being compressed by contact with a user's foot during use. By contrast, the cushioning function disclosed in both WO '372 and White suggests that contact between a user's foot and the foam is expected (because the foam is placed on the underside of a conventional, rather than an oversized, toe box). This suggests that compression of the foam layer, *e.g.*, during contact with a user's foot, is expected. [*E.g.*, White, col. 1, line 66 (foam layer is compressible).] This in turn suggests that compression of the respective foam layers resulting from such contact is likely, detracting from any possible thermal protection function.

For the reasons stated above, the combination of WO '372 and White does not yield the claimed invention. Accordingly, applicant submits that claim 10 is allowable over the cited references.

Claims 5, 6, 8, 9, 11, and 12 are dependent on claim 10. Applicant submits that these claims also are allowable over the cited references at least for the reasons stated above with respect to claim 10.

In addition to the reasons for allowability set forth above, WO '372, White, and Adam do not teach or suggest a material (foam) that is intended to provide a cold insulating function. Adams discloses a metatarsal guard 13 having a layer of fabric-backed foam applied to its inner

surface. The metatarsal guard 13 is adjacent to and supported at its forward lower edge by the toe protector 12. The shape of the metatarsal guard is "essentially that of the bootlast, so that its incorporation does not interfere with conventional boot forming techniques." [Adams, col. 2, lines 48-50.] Nothing in Adams teaches or suggests any lining for toe protector 12. Even if the Adams metatarsal guard could properly be construed to be a toe box, the foam layer on the underside of the metatarsal guard performs a cushioning function only.

Applicant respectfully submits that no motivation exists to increase the thickness of the foam layers disclosed in these references to achieve a desired temperature holding performance because none of these references is concerned with the thermal insulating properties of footwear including toe caps. Applicant therefore submits that claims 5 and 6 are allowable over the above-described combination of references.

* * * * *

CONCLUSION

For the reasons stated above, the claims presented herein satisfy the statutory requirements of patentability and are patentable over the cited references. Applicants respectfully submit that the claims are condition for allowance and request that a Notice of Allowance be issued.

Respectfully submitted,

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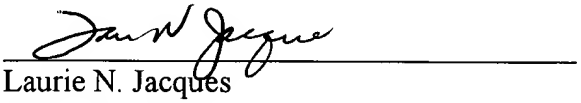
By: 

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